JAN 18 1962

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 671

AUBREY A. LARSEN, *Petitioner,*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

DEAN LAURENCE
HERBERT I. SHERMAN
753 Warner Building
Washington 4, D. C.
Attorneys for Petitioner

PRESS OF BYRON S. ADAMS, WASHINGTON, D. C.

COPY BOUND CLOSE IN CENTER

INDEX

	Page
Opinion Below	1
Jurisdiction	2
Questions Presented	2
Statute Involved	2
Statement	3
Jurisdiction	7
Reasons For Granting The Writ	9
1. The decision below has improperly decided an important question of federal law which has not been, but should be, settled by this Court	9
2. The decision below has decided a federal question in a way in conflict with applicable decisions of this Court	10
Conclusion	11

Appendix A (opinion of court below) 1a

CITATIONS

Cases:

A. & P. Tea Co. v. Supermarket Corp., 340 U.S. 147	10
Hoover Co. v. Coe, 325 U.S. 79	8
James v. Campbell, 104 U.S. 356	6, 11
McBride v. Teeple, 311 U.S. 649	7
Pacific Northwest Canning Co. v. Skookum Packers' Assn., 283 U.S. 858	7
Postum Cereal Co. v. California Fig Nut Co., 272 U.S. 693	7
Powder Company v. Powder Works, 98 U.S. 126	11
Special Equipment Co. v. Coe, 324 U.S. 370	8

STATUTES: Page

28 U.S.C. § 211 8

28 U.S.C. § 293 8

28 U.S.C. § 1256 ..... 2, 9

35 U.S.C. § 100 6

35 U.S.C. § 103 ..... 2, 4, 9, 10

35 U.S.C. § 112 6

MISCELLANEOUS:

Gilbert, The Constitutionality of Supreme Court Review of Patent and Trademark Decisions of the Court of Customs and Patents Appeals, 45 Geo. L.J. 645, 48 T.M.R. 8 8

Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States (Wolfson and Kurland ed.) 8

COPY BOUND CLOSE IN CENTER

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No.

AUBREY A. LARSEN, *Petitioner,*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent.*

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

Petitioner prays that a writ of certiorari issue to review the judgment of the United States Court of Customs and Patent Appeals, entered in the above-entitled case on July 21, 1961.

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals is reported at 292 F. 2d 531, 139 USPQ 209 and is reprinted in Appendix A hereto.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 21, 1961, and a timely petition for rehearing was denied on October 24, 1961. The jurisdiction of this Court is invoked under 28 U.S.C. section 1256. See discussion of jurisdiction, p. 7, infra.

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review on a writ of certiorari a decision of the Court of Customs and Patent Appeals finally denying certain claims in an otherwise allowable patent application.

2. Whether the Court of Customs and Patent Appeals, in denying patent claims directed to a novel, useful process for making a patentable chemical product for lack of invention, has misinterpreted and misapplied 35 U.S.C. section 103, which defines the applicable statutory standard of invention, particularly as to the terms "prior art" and "subject matter as a whole".

3. Whether the Court of Customs and Patent Appeals misapprehended the nature of the relationship between a patentable substance and a process for its production.

STATUTE INVOLVED

35 U.S.C. section 103:

> **Conditions for patentability; non-obvious subject matter**
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences

COPY BOUND CLOSE IN CENTER

between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

This proceeding grows out of the rejection by the Patent Office of certain claims in petitioner's otherwise allowable patent application, Serial 653 289, filed 1957 April 17, entitled "Iodinated Esters of Substituted Benzoic Acids and Preparation Thereof." Petitioner's patent application contains product claims directed to chemical compounds, and also process claims directed to the process of making the particular compounds of the product claims. Both types of claims were originally rejected over prior art. After affidavits were presented evidencing by a comparative showing that the claimed compounds had unexpected pharmacological properties not possessed by the prior art compounds, the Examiner allowed the product claims. The Examiner's final rejection of petitioner's process claims as unpatentable over Taub et al. 1 022 645 and Guest 2 561 468, which disclose the "type reaction" process applied to vaguely "analogous" starting material was affirmed by the Patent Office Board of Appeals and by the majority decision of the Court of Customs and Patent Appeals, two judges concurring separately and one judge dissenting, there being four separate opinions.

The issues, as presented to and discussed by the Court of Customs and Patent Appeals are legal in nature and all technical chemical aspects are merely

incidental. Thus, the question before the Court of Customs and Patent Appeals may be stated as: where

(1) it is known that A^1 plus B^1 yields A^1B^1,

(2) A is known

(3) B is known

(4) AB is patentable; i.e., it is novel, useful and unobvious.

Query: Is a process claim to "A plus B yields AB" patentable under the terms of 35 U.S.C. section 103, the governing statute?

35 U.S.C. reads, in pertinent part:

> "A patent may not be obtained . . . if the differences between the *subject matter sought to be patented* and the prior art are such that the *subject matter as a whole* would have been obvious . . . " [emphasis added]

Petitioner's main argument was: (1) He is entitled to a patent even if "the subject matter sought to be patented" would have been obvious, since the statutory test is the unobviousness of "the subject matter as a whole." (2) The "subject matter as a whole" includes the concept of the "subject matter sought to be patented" *plus* the tangible embodiment thereof with its attendant physical and applied use characteristics, i.e., the "subject matter as a whole" of process claims includes the starting material, the concept of the change in molecular structure wrought in the starting material during the course of the reaction, and the tangible product resulting therefrom with its inherent physical and applied use characteristics. (3) The product made is part of the "subject matter as a

COPY BOUND CLOSE IN CENTER

whole" and logically, if any, single part of a "whole" be unobvious, the "whole" is necessarily unobvious. Here the "subject matter as a whole" is necessarily unobvious, since the product made already has been established to be unobvious, claims thereto previously having been allowed.

The Court of Customs and Patent Appeals affirmed the Patent Office with four of the five judges writing separate opinions. There was a majority opinion by Chief Judge Worley, separate concurring opinions by Judges Rich and Martin and a dissent by Judge Smith. All of the opinions differ widely in reasoning and none of them considers specifically the fundamental point involved; i.e., the meaning of the term "subject matter as a whole", which term is the key term in the governing statutory provision.

Chief Judge Worley's opinion stated the issue as "whether a process for making a patentable compound is, ipso facto, a patentable process." He considered that petitioner's invention resided solely in the product and is not properly defined by the process claims, because once given the idea of the desired compound, the process for making the compound would be obvious.

Judge Rich concurred in the result, but not in Judge Worley's reasoning. He felt there was nothing *unobvious* in the selection of reactants A and B because that is dictated by the desire to produce AB, and also that the end result or properties of the products produced are not part of the process.

Judge Martin also concurred. He reasoned by analogy to machine situations that the claims recite only obvious esterification processes, and that the mere

selection of the particular compounds to be reacted doesn't impart patentability to the process.

Judge Smith dissented. He viewed the product and process claims as but different ways of claiming the disclosed invention. He chided the majority opinions for failing to consider the question of obviousness "at the time the invention was made"; i.e., for considering AB to be part of the prior art when it is not prior art as of the time the invention was made.

A Petition for Rehearing was filed, pointing out: (1) the reasoning of the majority appears bottomed on a misapprehension of the nature of the relationship between a patentable substance and a process for its production which, as set forth in *James* v. *Campbell*, 104 U.S. 356, 376, are the same thing; (2) the analogies in the two concurring opinions to a "process" for assembling a patentable machine are unsound because such a process is not a "process" within the meaning of 35 U.S.C. 100 and is not statutory subject matter; (3) the Court either misapprehended or overlooked the meaning of the term "subject matter as a whole" in 35 U.S.C. 103, and thus has not considered the question of the patentability of the claimed processes under the terms of the statute. (4) The Court misconstrued the Board of Appeals' ground of rejection and has scrambled the requirements of 35 U.S.C. 103 (which was involved) with 35 U.S.C. 112 (which was not involved in the appeal).

The Court of Customs and Patent Appeals denied the Petition for Rehearing.

COPY BOUND CLOSE IN CENTER

JURISDICTION

At the outset of this case is an important and unresolved question as to this Court's jurisdiction to review this or any patent case decided by the Court of Customs and Patent Appeals.

In a series of cases beginning with *Postum Cereal Co.* v. *California Fig Nut Co.*, 272 U.S. 693, this Court has held that neither patent nor trademark decisions of the nature now determined by the Court of Customs and Patent Appeals are reviewable in this Court. See also *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (a trademark case); *McBride* v. *Teeple*, 311 U.S. 649 (a patent case). The following reasons have been given: (1) since the Court of Customs and Patent Appeals decisions do not have a binding effect on the question of trademark or patent validity, they are not of such nature as to be reviewable by this Court under its Article III jurisdiction; (2) the Court of Customs and Patent Appeals proceedings are administrative in nature and are not "cases" or "controversies" within the meaning of Article III; and (3) the absence of any statutory authorization for review of such proceedings by this Court.

Petitioner submits that all of the foregoing reasons have either disappeared or are inapplicable to this case and that this Court possesses full power to review the decision below.

(1) In this case, the Court of Customs and Patent Appeals determined that certain process claims in a patent application should be denied and hence there is nothing the validity of which can be called into question in another court at another time. Moreover, in

Hoover Co. v. *Coe,* 325 U.S. 79, and in *Special Equipment Co.* v. *Coe,* 324 U.S. 370, this Court granted full review of District Court patent proceedings even though the District Court judgments had no more binding effect on the issue of validity than do judgments of the Court of Customs and Patent Appeals. These two subsequent decisions indicate an abandonment of the no-binding-judgment argument advanced in the *Postum* case. See Robertson and Kirkham, Jurisdiction of the Supreme Court of the United States (Wolfson and Kurland ed.) § 251, pp. 442-448; Gilbert, The Constitutionality of Supreme Court Review of Patent and Trademark Decisions of the Court of Customs and Patent Appeals, 45 Geo. L. J. 645, 48 T.M.R. 8.

(2) The decisions of the Court of Customs and Patent Appeals can no longer be considered as administrative in nature. That tribunal in 1958 was accorded the status of "a court established under article III of the Constitution of the United States," 72 Stat. 848, 28 U.S.C. § 211, and its judgments must be considered to be judicial pronouncements on cases and controversies. The parties before it act in a truly adversary capacity and the court interprets and applies the legislative standards prescribed by Congress in rendering its decisions.

Further, the judges of the Court of Customs and Patent Appeals are now treated the same as circuit judges and district judges under 28 U.S.C. 293, in that they may be temporarily assigned interchangeably.

(3) This Court now has full and unconditional statutory authority to review any and all decisions of the Court of Customs and Patent Appeals. The

COPY BOUND CLOSE IN CENTER

1948 recodification of the Judicial Code plainly states: "Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari." 28 U.S.C. § 1256. This unambiguous provision indicates no legislative intent to confine review to any particular type of case or to exclude either patent or trademark cases. Also, Rule 19 of this Court's rules provides that the same general considerations governing review of decisions of the Courts of Appeals "will control in respect of petitions for writs of certiorari to review judgments of the Court of Claims, of the Court of Customs and Patent Appeals, or of any other court whose determinations are by law reviewable on writ of certiorari."

The foregoing factors combine to make evident the existence of jurisdiction in this Court to review the judgment below.

REASONS FOR GRANTING THE WRIT

1. The decision below has improperly decided an important question of federal law which has not been, but should be, settled by this Court

The decision below decides a fundamental question of the application and interpretation of what is perhaps the most important single section of the patent statute, 35 U.S.C. 103, which states the "standard of invention" to be applied in determining patentability. This section of the patent statute has never been interpreted by this Court, as it was first introduced in the 1952 Patent Act and had no precursor in previous patent statutes. The rejection by the Patent Office of process claims in the situation here involved represented a substantial change in the practice of the Patent Office where process claims were usually allowed

almost as a matter of course along with the product claims. The decision in this case will be applicable and controlling in hundreds of pending patent applications, since it is common, in patent applications claiming a novel chemical product, to include process claims. The decision below is a case of first impression in this country. However, the questions involved have been adjudicated contra to the decision in this case in Canada and Great Britain, which have a patent jurisprudence generally similar to ours. The decision below was a split decision by a divided Court, whose four separate opinions express divergent views. The decision below decides the interpretation of 35 U.S.C. 103 by default, since the Court specifically refused to grapple with the meaning of the key term "subject matter as a whole," and inferentially gave the term "prior art" a meaning inconsistent with the other requirements of that section.

In *A. & P. Tea Co.* v. *Supermarket Corp.*, 340 U.S. 147, 155, Mr. Justice Douglas pointed out in his concurring opinion that "The standard of patentability is a constitutional standard." Failure of the decision below to consider correctly the language of the provision of the statute which deals with the standard of patentability, makes appropriate the exercise of this Court's certiorari jurisdiction.

2. The decision below has decided a federal question in a way in conflict with applicable decisions of this Court

The decision below decides the question of the patentability of a process to make a patentable product in a way which conflicts with this Court's view of the relationship between the various classes of statutory

COPY BOUND CLOSE IN CENTER

subject matter which was expressed in *James* v. *Campbell,* 104 U.S. 356, 376 as:

> "A patent for a process and a patent for an implement or a machine are very different things. Powder Company v. Powder Works, 98 U.S. 126. Where a new process produces a new substance, the invention of the process is the same as the invention of the substance. . . ."

CONCLUSION

For the foregoing reasons, this petition for a writ of certiorari to the Court of Customs and Patent Appeals should be granted.

Respectfully submitted,

DEAN LAURENCE
HERBERT I. SHERMAN
753 Warner Building
Washington 4, D. C.
Attorneys for Petitioner

January 1962

APPENDIX A

APPLICATION OF AUBREY A. LARSEN

Patent Appeal No. 6686

UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

July 21, 1961

Rehearing Denied Oct. 24, 1961

Before WORLEY, Chief Judge, and RICH, MARTIN, and SMITH, Associate Judges, and Judge WILLIAM H. KIRKPATRICK.[1]

WORLEY, Chief Judge.

This is an appeal from the decision of the Board of Appeals of the United States Patent Office affirming the rejection by the Primary Examiner of claims 11 to 20, inclusive, and 22 of appellant's application, No. 653,289, for a patent on organic compounds and processes of preparing them. All the appealed claims are directed to processes, the claims to the compounds having been allowed.

Since the issue is essentially one of law, the scope of the claims is not material, and it is unnecessary to reproduce any claim here.

The references relied on are

Taub et al 1,022,645 April 9, 1912.

Guest 2,561,468 July 24, 1951.

The claimed processes involve the production of esters of substituted benzoic acids by reacting an alkali metal salt of such an acid and an appropriate halohydrin or epoxide.

---

[1] United States Senior District Judge for the Eastern District of Pennsylvania, designated to participate in place of Judge O'CONNELL, pursuant to provisions of Section 294(d), Title 28 United States Code.

The compounds reacted are conceded to be old. The Taub et al. patent shows the production of an ester by reacting an appropriate alkali metal salt of a substituted benzoic acid and a halohydrin. The Guest patent discloses the use of an epoxide for esterification of the benzoic acid derivative and, as noted by the board, was relied on mainly in connection with claim 22 which involves the use of an epoxide.

In view of the obviously close parallel between the claimed processes and those of the references, we agree with the conclusion of the Patent Office that if the compounds recited in appellant's allowed claims were disclosed in the prior art it would be obvious to a person of ordinary skill in the art to prepare them by the processes set forth in the appealed claims. It is unnecessary to discuss this point further since appellant does not dispute it, but states in his brief that

> "• • • For purposes of this appeal, appellant concedes that, if the products made by his process were not novel and patentable, the process might not be patentable over the references cited."

The issue presented here, therefore, is whether a process for making a patentable compound is, ipso facto, a patentable process.

There is substantial discussion in the briefs here as to whether the claimed processes would be obvious in view of the prior art, but, as we understand the board's decision, the principal basis of rejection is that appellant's invention resides solely in the product and is not properly defined by the process claim. This appears from the following statement in the board's opinion:

> "• • • If in the instant case the process claims do not point out the invention, they might properly be subject to this criticism. • • • The major question is

COPY BOUND CLOSE IN CENTER

whether such claims define his, or any, invention and this we think is a proper subject of inquiry by the examiner.

* * * * * *

"* * * Therefore under the above stated principles of patent law, we feel compelled to hold that appellant's invention does not reside in the process of making an ester. * * *"

While the entire record of appellant's application has not been presented here, it is clear from the examiner's answer to the appeal that the allowance of the claims to the compounds was based on the fact that they possessed unique, and presumably unexpected, properties. Since there was nothing to indicate that the compounds, when made, would have these properties, it was not obvious to make the compounds. In such a case the allowance of claims to the compounds must depend on the proposition that it was unobvious to conceive the idea of producing them, within the meaning of Title 35 U.S.C. § 103.

Under these circumstances, however, the inventive concept is that of the compounds themselves. When they have been conceived, the processes by which they may be prepared may or may not be obvious. If, as is the case here, such processes, given the idea of the compound, are obvious then it is apparent that the invention resides in the compounds *per se* and is not properly defined as a process.

[1] The fallacy of appellant's contention that "if a product be patentable, a claim to a process for producing such product is patentable" is apparent upon considering the not infrequent situations in which a new product may be made by any one of several obvious processes. It seems clear that in such a case each of those obvious methods could not properly be considered patentable, and yet there is logically no more reason for allowing claims to any one than to the others. The fact that an applicant sees fit to

disclose a particular one of the processes should have no bearing on its patentability.

A case in point is Wirebounds Patents Co. et al v. H. R. Gibbons Box Co., 7 Cir., 25 F. 2d 363, 365. In holding the method claims there involved unpatentable, the court said:

> "Moreover, the method patent contains nothing but the natural and obvious method of producing the box. • • • It cannot be considered invention to describe and claim a process, or to produce a machine, or formulate at method which any successful mechanic would produce when required to effectuate a given result. • • •"

Another situation somewhat similar to the instant one was involved in In re Kulieke, 277 F. 2d 948, 951, 47 CCPA 943. There claims had been allowed on a railway coupler knuckle of specific construction and appellant sought the allowance of claims on a core mold assembly designed for casting the coupler. In refusing the claims on the ground that the invention resided solely in the coupler, the court said:

> "From our consideration of the record, we agree with appellant that there is but a single invention here involved, but we disagree with the conclusion he would have us draw from this fact. In our opinion this single invention is found in the coupler knuckle per se. We have found nothing about the mold and core assembly, as claimed, which indicates that it would be unobvious to one having the ordinary skills in this art to form such an assembly to produce the case knuckle. • • • Once the engineering design of the casting has been determined, the mold and cores will necessarily follow that design."

[2] While that case relates to the mold for making a product rather than a process of making it, the same reasoning is applicable in both cases. When the sole inventive

COPY BOUND CLOSE IN CENTER

concept resides in the product the claims should be limited to product claims.

[3] Appellant relies heavily on decisions in Canada and Great Britain which allegedly hold process claims allowable under circumstances similar to those of the instant case. We have repeatedly held that, in view of the differences between foreign patent laws and those of the United States, the allowance of patent claims in foreign countries is not pertinent to the question whether similar claims should be allowed here; In re Guinot, 76 F. 2d 134, 22 CCPA 1067; In re Kleine [Pfannenstiel, and Matthaes], 83 F. 2d 928, 23 CCPA 1216; and In re Kluter, 92 F. 2d 906, 25 CCPA 730. No reason appears for reaching a different conclusion here.

[4] This is not a case in which it is doubtful whether the invention resides in the process or the product. Clearly the invention lies in the compounds themselves, by whatever process produced, and we agree with the board that the allowance of claims to a particularly, although obvious, method of producing them which happens to be disclosed in appellant's application would not constitute a proper definition of appellant's invention.

In view of the foregoing conclusion it is unnecessary to consider the extensive arguments advanced in the briefs as to what is meant by the expression "that the subject matter as a whole would have been obvious at the time the invention was made" in 35 U.S.C. § 103.

The decision is *affirmed*.

Affirmed.

RICH, Judge (concurring).

I reach the conclusion to affirm on the basis only of the following reasoning.

If we analyze patentability in the terms provided for us by Congress, we have to apply the prerequisites of novelty,

utility, and unobviousness to the subject matter claimed, which is a process.

Utility can be disposed of because it has not been questioned by the Patent Office, and properly so because one could not very well contend that a process by which a product can successfully be made has no utility.

Novelty we have, not in the sense of manipulative procedures, but only in a *selection* of known compounds to be reacted. The examiner admits the presence of novelty. So far as manipulation is concerned, all the claims call for is "reacting." It is not new in chemistry to *react* two inherently reactive compounds. It has not been shown, however, that the art discloses reacting A with B, to simplify the subject matter of the claimed processes, so we must admit there would be novelty in doing so.

Wond it be *obvious* to react A with B? Here lies the crux of the problem. I agree with the examiner that "applicant obtains exactly what the art teaches will be obtained" and I do not understand that applicant denies it, in the sense of the exact *product* obtained. But, he says, the art does not suggest reacting A with B—the admittedly known materials reacted by what applicant admits is "a known type reaction procedure." We are asked, however, to give weight to "the material acted upon and the end result." The end result will call AB, the reaction product. I do not known what other result the claimed processes could have.

The "material acted upon" is material A and material B which act upon each other, or react. I have already said there is novelty in their selection. I am unable, however, to find anything *unobvious* in their selection because that is dictated by the desire to produce AB. While selecting A and selecting B to react with it may not be the only way to produce AB, it cannot be contended that it is not the obvious thing to do if AB is what you want to make.

The "end result" applicant asks us to consider is described by him variously as "the physical attributes of the result," "the properties of the products produced," and, in the examiner's words, "the particular utility or properties of the final chemical compound." My response to this is that if it be the fact that the final compound AB possesses unique, unexpected, surprising, or highly useful properties, they *inhere in the product* AB, not in A alone, B alone, or *in the process* of reacting them.. While such attributes in a product may make it, the product, patentable they do not make the process patentable because they are in no way a part of the process. They are attributes of the product alone and would so remain though it were made by an entirely different process.

If we are asked to jumble up the product and the process and regard it as all the same thing, whether dubbed "the invention as a whole" or given any other name, and it almost seems that we are then I say this exhibits a fine disregard for the requirement section 112 that the applicant shall particularly point out and distinctly claim his invention. What this statutory requirement amounts to as the case law has developed it, is that applicant, with distinctness and particularity, shall define in "claims" that part of his disclosed invention which possesses the attributes of patentability under the statute, for until he does, his "claims," which under well-settled precedents define the scope and content of his patent monopoly, cannot be granted or allowed.

What can be *granted* in the form of patent claims does not depend, to use words from section 112, on what "the applicant regards as his invention," but on whether the subject matter he chooses to so regard and define is new, useful, unobvious, and is his invention.

The process claims define, in effect, only the reaction of A with B to produce AB, the reaction admittedly being old except for the selection of A and B from the mass of

known materials available. Though they point out novel subject matter, these claims, tested against the prior art, do not define anything unobvious to one of ordinary skill in this art.

This art is chemistry. Were we in a mechanical art, I think no one would trouble to argue that every time a new tool or machine is invented one can obtain process claims directed to nothing more than the obvious steps of selecting the materials, forming the parts on suitable machines, and assembling them in their operative relationship. I can see no distinction in principle here. Yet that is what applicant contends in advancing in his conclusion

> "the proposition that, if a product be patentable, a claim to a process for producing such patentable product, is patentable, at least when present in the same application."

That proposition carries the seeds of its own destruction. It assumes that every patentable product is produced by an *unobvious* process.

What I have said is no other than what the examiner said in his holding that

> "• • • the processes claimed herein are new and useful but not *inventive.*
>
> • • • • • •
>
> "Patented claims are granted for only one reason and that is because they are *inventive*; the process claims herein are *not inventive.*" (My emphasis.)

The difference is that I have said it in terms laid down by Congress, deliberately used in the statute for the sake of clarity, which I find more conducive to clear thinking than to discuss the patentability of an invention in terms of its

COPY BOUND CLOSE IN CENTER

being "inventive." The statute makes no such requirement.[1]

The reason the invention[2] before us is not patentable under the statute is that it is obvious, notwithstanding its difference from the prior art. 35 U.S.C. § 103.

I therefore agree with the conclusion of the examiner in his Answer, and almost with his mode of stating it, which is:

> "It is therefore submitted that the process claims are properly rejected as unpatentable over the art in that they recite no more than the obvious application of old esterification processes and that the patentability of a chemical process can not be predicated upon the inventiveness [patentability or unobviousness?] of the product produced thereby."

There is a certain amount of logic in holding a product to be unobvious because of the discovery in it of unobvious properties, such as its ability to act as a non-toxic X-ray contrast agent, because the properties inhere in the product. But I see neither logic nor sound interpretation of the patent law in transferring such properties from the product in which they inhere to a process of making the product in which they do not.

MARTIN, Judge (concurring).

---

[1] I am well aware, having participated in the venture, that section 103 was intended to be and is a "codification" of the requirement of "invention" which was developed in the courts and was never, before 1952, in the statute. The term "invention" as denoting a prerequisite to patentability had, however, acquired so many diverse meanings that in drafting section 103 its use was assiduously avoided. I think its avoidance by those attempting to apply the statute in the future will assist materially in carrying out the intent of the legislature.

[2] "The invention" cannot be anything other than what is claimed.

I am of the opinion that the decision of the board should be affirmed for the following reason:

It appears from the prior art that the appealed claims recite only obvious esterification processes. I do not believe the mere selection of the particular compounds to be reacted imparts patentability to these *process* claims any more than the selection of particular parts of a machine would render an obvious process for making the machine patentable.

Although I am aware that machines differ from chemical compounds in that the individual parts of a machine retain their identity and merely interact or cooperate in producing some desired result while chemical reactants lose their identity in reacting to produce a new substance, I do not believe this difference is significant in deciding the issue before us. The prior art in this instance indicates to me that the chemist of ordinary skill would know that appellant's chemical reactants would react as stated and claimed.

SMITH, Judge (dissenting).

My analysis of the invention involved here differs from that of my colleagues and leads me to a different conclusion on the issue of patentability of the appealed process claims. The specification and claims seem to me to show that the invention relates to decreasing the toxicity of the alkyl esters of certain triiorobenzoic acids, particularly, the ethyl ester of 3-acetamdo-2,4,6-triiodobenzoic acid by the placement of hydroxy groups in the alkyl ester moiety in such positions that the carbon atom adjacent to the carboxyl group is always unsubstituted. The specification states:

> "This restriction of the placement of the hydroxy groups eliminates the hemiacetal type derivatives which would result from having a hydroxy group on the carbon atom attached to the carboxy group."

COPY BOUND CLOSE IN CENTER

Therefore, I view the product and process claims as but different ways of claiming the disclosed invention. At the time this invention was made, the prior art did not disclose either the claimed product or the claimed process for making that product. I am unable to find a factual basis for the assumption stated in the majority opinion written by Judge Worley, that "clearly the invention lies in the compounds themselves, by whatever process produced."

In rejecting applicant's process claims as "obvious" we should determine what would have been obvious from the prior art to one of ordinary skills in the chemical arts *"at the time the invention was made."* (35 U.S.C. § 103) (Emphasis added.)

The prior art "at the time the invention was made," must, in my opinion, exclude applicant's new compounds. It is only as the prior art is viewed *after* applicant's invention of the new compounds that the process claimed has been found by the majority opinion written by Judge Worley to be obvious to a person of ordinary skill in this art. This, in my judgment, is not a correct application of 35 U.S.C. § 103.

While Judge Rich's concurring opinion does not state this assumption as directly as does the majority opinion written by Judge Worley, it seems to me it is implicit in the reasoning by which the conclusion is reached that it would be obvious to react A and B "because that is dictated by the desire to produce AB." The same assumption underlies his further statement "while selecting A and selecting B to react with it may not be the only way to produce AB, it cannot be contended that it is not the obvious thing to do if *AB is what you want to make.*" (Emphasis added.)

Since I am unwilling to consider the new compounds as a part of the prior art at the time the invention was made, I would reverse the decision of the board.

INDEX

	Page
Opinion below	1
Jurisdiction	1
Questions presented	2
Statute involved	2
Statement	2
Argument	4
Conclusion	11

CITATIONS

Cases:

Anraku v. *General Electric Co.*, 80 F. 2d 958 — 9

Bauer Bros. Co. v. *Bogalusa Paper Co.*, 96 F. 2d 991 — 6

Binney & Smith Co. v. *United Carbon Co.*, 125 F. 2d 255 — 8

Buono v. *Yankee Maid Dress Corporation*, 77 F. 2d 274 — 8

Cady, In re, 77 F. 2d 106 — 8

Cochrane v. *Badische Anilin & Soda Fabrik*, 111 U.S. 293 — 9

Cochrane v. *Deener*, 94 U.S. 780 — 6

Commissariat à L'Energie Atomique v. *Watson*, No. 826, Oct. Term, 1959, certiorari denied, 362 U.S. 977 — 6

Expanded Metal Co. v. *Bradford*, 214 U.S. 366 — 6

General Electric Co. v. *De Forest Radio Co.*, 17 F. 2d 90, modified, 28 F. 2d 641, certiorari denied, 278 U.S. 656 — 8

Holland Furniture Co. v. *Perkins Glue Co.*, 277 U.S. 245 — 8

James v. *Campbell*, 104 U.S. 356 — 8, 9

Malina v. *Grisman*, 20 F. 2d 406, affirmed *per curiam*, 20 F. 2d 409 — 8

McBride v. *Teeple*, 311 U.S. 649 — 5

Oxford Varnish Corporation v. *General Motors Corp.*, 120 F. 2d 44 — 7

Pacific Northwest Canning Co. v. *Skookum Packers' Assn.*, 283 U.S. 858 — 5

Paramount Publix Corp. v. *American Tri-Ergon Corp.*, 294 U.S. 464 — 6

829043—62

Cases—Continued

	Page
Postum Cereal Co. v. *Calif. Fig Nut Co.*, 272 U.S. 693	4
Risdon Locomotive Works v. *Medart*, 158 U.S. 68	9
Rubber Company v. *Goodyear*, 9 Wall. 788	7, 8
Steinfur Patents Corporation v. *J. Meyerson, Inc.*, 56 F. 2d 372	8
Touway, Application of, 264 F. 2d 901	8
Westinghouse v. *Boyden Power Brake Co.*, 170 U.S. 537	9
Constitution and Statutes:	
Constitution of the United States: Article III	5
Act of March 2, 1929, c. 488, Sections 1–4, 45 Stat. 1475	5
Act of June 25, 1948, 62 Stat. 683	5
Act of July 19, 1952, c. 950, Section 103, 66 Stat. 798, 35 U.S.C. 103	2, 9
28 U.S.C. 211	5
28 U.S.C. 1256	1, 5
Miscellaneous:	
H.R. 7794, 82d Cong., 2d Sess.	9
H. Rept. No. 1923, 82d Cong., 2d Sess.:	
P. 7	10
P. 18	10
S. Rept. 1979, 82d Cong., 2d Sess., p. 6	10

In the Supreme Court of the United States

OCTOBER TERM, 1961

No. 671

AUBREY A. LARSEN, PETITIONER

v.

DAVID L. LADD, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the United States Court of Customs and Patent Appeals (Pet. App. 1a) is reported at 292 F. 2d 531.

JURISDICTION

The judgment of the Court of Customs and Patent Appeals was entered on July 21, 1961 (Pet. App. 1a). A timely petition for rehearing was denied on October 24, 1961 (Pet. App. 1a). The petition for a writ of certiorari was filed on January 18, 1962. The petitioner attempts to invoke the jurisdiction of this Court under 28 U.S.C. 1256 (Pet. 2).

QUESTIONS PRESENTED

1. Whether this Court has jurisdiction to review a decision by the United States Court of Customs and Patent Appeals which affirmed the denial of certain patent claims by the Board of Appeals of the United States Patent Office.

2. Whether the United States Patent Office, whenever it allows as patentable certain claims to a chemical product, must also allow claims to the process by which that product was made, regardless of the patentability of the process standing alone.

STATUTE INVOLVED

The Act of July 19, 1952, c. 950, Section 103, 66 Stat. 798, 35 U.S.C. 103, provides in pertinent part:

> *Conditions for patentability; non-obvious subject matter*
>
> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

STATEMENT

Petitioner, in 1957, applied to the Patent Office for a patent on certain chemical compounds and on the processes by which the compounds were made (Pet.

COPY BOUND CLOSE IN CENTER

3, Pet. App. 1a). The Examiner allowed the product claims to the compounds but disallowed the process claims (Pet. 3, Pet. App. 1a). The process claims, involving "the production of esters of substituted benzoic acids by reacting an alkali metal salt of such an acid and an appropriate halohydrin or epoxide" (Pet. App. 1a), were held to be unpatentable over the prior art (Pet. App. 2a). The Examiner's decision was subsequently upheld by the Board of Appeals of the Patent Office, and petitioner then appealed to the United States Court of Customs and Patent Appeals (Pet. App. 1a).

The Court of Customs and Patent Appeals agreed with the Patent Office's conclusion that petitioner's invention was contained in the product claims, not the process or method claims, and "that if the compounds recited in appellant's allowed claims were disclosed in the prior art it would be obvious to a person of ordinary skill in the art to prepare them by the processes set forth" (Pet. App. 2a). The court further noted that petitioner had conceded that the process itself might not be patentable over the prior art, but contended that the process claims should have been allowed merely because the resulting products were found patentable (Pet. App. 2a).[1] Thus, the only issue presented was "whether a process for making a patentable compound is, ipso facto, a patent-

[1] Petitioner stated in his brief to the court below: "For purposes of this appeal, appellant concedes that, if the products made by his process were not novel and patentable, the process might not be patentable over the references cited" (Pet. App. 2a).

able process" (Pet. App. 2a). The court, concluding that "[w]hen the sole inventive concept resides in the product the claims should be limited to product claims" (Pet. App. 4a–5a), affirmed the decision of the Patent Office (Judge Smith dissenting).

ARGUMENT

It is, as petitioner must recognize, very doubtful whether decisions of the Court of Customs and Patent Appeals, in patent cases on appeal from the Patent Office, are now reviewable on certiorari by this Court, but there is no need for this Court to resolve that doubt in this case. Even if this Court has jurisdiction, there is no occasion for review because the decision below is plainly correct on the merits. It has long been established in patent law that process claims and claims for the resulting products are independent and must be viewed separately to determine patentability. The decision below correctly applies that settled principle to the facts of this litigation, and there is no conflict of decisions.

1. In *Postum Cereal Co.* v. *Calif. Fig Nut Co.*, 272 U.S. 693, this Court held that it lacked jurisdiction to review decisions of the Court of Appeals of the District of Columbia in appeals from determinations of the Patent Office in patent and trademark applications. It was said that the decision in an appeal from the Patent Office was not a judicial judgment but was "merely an instruction * * * by a court which is made part of the machinery of the Patent Office for administrative purposes." 272 U.S. 698–699. The jurisdiction of the Court of Appeals of

COPY BOUND CLOSE IN CENTER

the District of Columbia over patent and trademark matters was subsequently transferred to the Court of Customs and Patent Appeals. Act of March 2, 1929, c. 488, Sections 1–4, 45 Stat. 1475. But the basic nature of the proceeding was not changed, and thereafter, in denying certiorari in *Pacific Northwest Canning Co.* v. *Skookum Packers' Assn.*, 283 U.S. 858 (trademark case), and in *McBride* v. *Teeple*, 311 U.S. 649 (patent case), the Court specifically noted that the denial was "for want of jurisdiction," citing *Postum Cereal.* In subsequent patent cases, the Court has merely denied certiorari, without more.

Petitioner relies upon two relatively recent statutory changes as indicating that patent decisions of the Court of Customs and Patent Appeals are now reviewable by this Court. The first statutory change was made by 28 U.S.C. 1256—part of the Act of June 25, 1948, 62 Stat. 683, codifying Title 28 of the United States Code—which provided generally, for the first time, that cases in the Court of Customs and Patent Appeals are reviewable by this Court. The other statutory change is the 1958 amendment to 28 U.S.C. 211, designating the Court of Customs and Patent Appeals as a court established under Article III of the Constitution.

We believe that, despite some of the language in the *Postum Cereal* opinion, there are no constitutional obstacles to review by this Court of the patent rulings of the court below (see the Brief for the United States in *Lurk* v. *United States*, No. 481, this Term, pp. 104 *et seq.*), but at the same time there is the gravest doubt whether the Congress has as yet

vested this Court with that jurisdiction. See the government's brief in opposition to certiorari in *Commissariat à L'Energie Atomique* v. *Watson,* No. 826, Oct. Term, 1959, pp. 6–9, certiorari denied, 362 U.S. 977.

2. However, even if the Court were to decide that it now has jurisdiction to review patent decisions of the Court of Customs and Patent Appeals, there would be no occasion to exercise that jurisdiction in this case. The contention advanced by petitioner—that whenever a product is patentable the method by which it is made is also patentable regardless of the novelty of the method—is refuted by many decisions of this Court and the lower federal courts. A process or method by which a particular product is made, whether the process be mechanical or chemical, may be the subject of allowable patent claims; but, in order for such claims to be patentable, the process itself must meet the standards of patentability. This was emphasized by the Court in *Paramount Corp.* v. *Tri-Ergon Corp.,* 294 U.S. 464, 473:

> To claim the merit of invention the patented process must itself possess novelty. The application of an old process to a new and closely analogous subject matter, plainly indicated by the prior art as an appropriate subject of the process, is not invention. * * *

See, also, *Cochrane* v. *Deener,* 94 U.S. 780, 787–788; *Expanded Metal Co.* v. *Bradford,* 214 U.S. 366, 381–386; *Bauer Bros. Co.* v. *Bogalusa Paper Co.,* 96 F. 2d 991, 994 (C.A. 5).

In the present case, both the Patent Office and the Court of Customs and Patent Appeals found as a fact

COPY BOUND CLOSE IN CENTER

that petitioner's process claims did not possess novelty. This the petitioner does not dispute, but merely relies on the novelty of the product. However, as the Court of Appeals for the Sixth Circuit has said: "The fact that a new subject is reproduced does not establish the validity of a process patent unless the method of reproduction is new. *Paramount Publix Corp.* v. *American Tri-Ergon Corp.*, 294 U.S. 464, 473 * * *." *Oxford Varnish Corporation* v. *General Motors Corp.*, 120 F. 2d 44, 47 (C.A. 6). Since petitioner's process claims standing alone lack invention, they could not be the subject of allowable patent claims.

The correctness of the decision below is further underscored by *Rubber Company* v. *Goodyear*, 9 Wall. 788, 796. There this Court, in language directly apposite to petitioner's contention, stated:

> A machine may be new, and the product or manufacture proceeding from it may be old. In that case the former would be patentable and the latter not. The machine may be substantially old and the product new. In that event the latter, and not the former, would be patentable. Both may be new, or both may be old. In the former case, both would be patentable; in the latter neither. *The same remarks apply to processes and their results. Patentability may exist as to either, neither, or both, according to the fact of novelty, or the opposite. The patentability, or the issuing of a patent as to one, in nowise affects the rights of the inventor or discoverer in respect to the other. They are wholly disconnected and independent facts.* Such is

> the sound and necessary construction of the statute. [Emphasis added.]

While in some situations claims that can be designated "process claims" may be viewed as integral parts of the products, generally "method" or "process" claims are, as the *Rubber Company* case points out, independent and must stand or fall on their own, irrespective of the patentability of the products.[2] In *Holland Furniture Co.* v. *Perkins Glue Co.*, 277 U.S. 245, 254–258, the Court pointed out that the term "process" is sometimes used, inaccurately, to describe "an essential ingredient of a composition of matter," and in such a case the "process" is "inseparable from the composition itself." 277 U.S. at 255–256. However, where the term is employed to describe the method by which a product is made, the Court reaffirmed the applicability of the rule that the process and product claims are distinct and inde-

---

[2] To the same effect as the *Rubber Company* case, that process claims and product claims are separate and independent with respect to patentability, see, *In re Cady*, 77 F. 2d 106, 109 (C.C.P.A.); *Buono* v. *Yankee Maid Dress Corporation*, 77 F. 2d 274, 279 (C.A. 2); *Binney & Smith Co.* v. *United Carbon Co.*, 125 F. 2d 255, 258 (C.A. 4); *General Electric Co.* v. *De Forest Radio Co.*, 17 F. 2d 90, 96 (D. Del.), modified, 28 F. 2d 641 (C.A. 3), certiorari denied, 278 U.S. 656; *Malina* v. *Grisman*, 20 F. 2d 406 (E.D. N.Y.), affirmed *per curiam*, 20 F. 2d 409 (C.A. 2); *Steinfur Patents Corporation* v. *J. Meyerson, Inc.*, 56 F. 2d 372 (E.D. N.Y.); *cf.*, *Application of Touvay*, 264 F. 2d 901, 903 (C.C.P.A.), where the court stated: "It is well settled that the allowability of one set of claims cannot be predicated on the patentability of other claims in the same application. * * *"

pendent, and that "[e]ither or both may be patentable." 277 U.S. at 255.[3]

There is absolutely no merit to petitioner's argument that 35 U.S.C. 103, *supra*, p. 2, changes the prior law and enlarges the area of patentable claims to include process claims where the process itself lacks invention. To the contrary, it is clear from the terms of Section 103 that its purpose was to codify a rule designed to limit the type of claim on which a patent may be granted. It provides that, even if there are differences between the subject matter of the claims and the prior art, a patent shall not issue if the "subject matter as a whole would have been obvious" to a person skilled in the art. Certainly, this does not support the contention that process claims, lacking novelty, are patentable merely because the resulting product is patentable.

Moreover, the legislative history of 35 U.S.C. 103 refutes the petitioner's assertion that the section was designed to change prior law and cause allowance of claims that had previously been disallowed. The report of the House of Representatives Committee on the Judiciary, accompanying H.R. 7794, 82d Cong., 2d Sess., which was the bill to revise and codify

---

[3] For other cases describing this distinction, see, *e.g.*, *Cochrane* v. *Badische Anilin & Soda Fabrik*, 111 U.S. 293, 310; *Anraku* v. *General Electric Co.*, 80 F. 2d 958, 964 (C.A. 9). The term "process" is also sometimes used in patent cases in a third sense, not here relevant, to describe the "function" or "use" of a particular product. See, *e.g.*, *James* v. *Campbell*, 104 U.S. 356; *Risdon Locomotive Works* v. *Medart*, 158 U.S. 68; *Westinghouse* v. *Boyden Power Brake Co.*, 170 U.S. 537.

Title 35 of the United States Code, stated (H. Rept. No. 1923, 82d Cong., 2d Sess., p. 7):

> Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.
>
> That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases.

To the same effect, see p. 18 of H. Rept. No. 1923, *supra*, and S. Rept. 1979, 82d Cong., 2d Sess., p. 6. It is clear from both the language of the section and its legislative history that no change in the prior law was contemplated. And, as we have pointed out, it

is also clear from that prior law that a process claim lacking invention in itself does not become patentable merely because a patentable product may result.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

ARCHIBALD COX,
Solicitor General.
WILLIAM H. ORRICK, JR.,
Assistant Attorney General.
MORTON HOLLANDER,
JOHN C. ELDRIDGE,
Attorneys.

FEBRUARY 1962.

U.S. GOVERNMENT PRINTING OFFICE, 1962

IN THE

Supreme Court of the United States

OCTOBER TERM, 1961

No. 671

AUBREY A. LARSEN, *Petitioner,*

v.

DAVID L. LADD, Commissioner of Patents, *Respondent.*

On Petition for a Writ of Certiorari to the United States Court of Customs and Patent Appeals

REPLY BRIEF FOR PETITIONER

Petitioner wishes to reply to certain inaccurate statements in the Brief for The Respondent In Opposition filed by the government.

I. In the three different places in the government brief a statement is made to the effect that petitioner's process claims do not possess novelty. These statements are:

government brief—p. 6:

"The contention advanced by petitioner—that whenever a product is patentable the method by

which it is made is also patentable regardless of the novelty of the method—is refuted by many decisions of this Court and the lower federal courts."

government brief—p. 6-7:

"In the present case, both the Patent Office and the Court of Customs and Patent Appeals found as a fact that petitioner's process claims did not possess novelty. This the petitioner does not dispute, but merely relies on the novelty of the product."

government brief—p. 9:

"Certainly, this does not support the contention that process claims, lacking novelty, are patentable merely because the resulting product is patentable."

The above-quoted statements from the government's brief are flatly incorrect. Petitioner's process claims are novel. If they were not novel, then the claims would be statutorily barred under 35 U.S.C. Section 102, and petitioner would never have troubled this Court. The Court below expressly recognized that petitioner's process was novel. Thus, Judge Rich's concurring opinion says, at Appendix to Petition, p. 6a: *"Novelty,* we have, * * *"

The government brief completely misses the point by confusing "novelty" (35 U.S.C. 102) with "unobviousness" (35 U.S.C. 103). A claimed process either is novel or it is not. Here it is novel.

The sole question is whether the claimed process is sufficiently unobvious to be "inventive" under 35 U.S.C. Section 103. Petitioner relies strongly on the finding that the product which is made by his novel

COPY BOUND CLOSE IN CENTER

process is patentable (i.e. novel, useful and inventive) because this legal conclusion is bottomed on facts, already established, which facts also establish the patentability of the claimed process, even though the latter be viewed separately. A rough analogy might be made to the situation where two individuals are charged with conspiring with each other to commit a crime. If one be found not guilty, this establishes that the other is not guilty. So here, while the invention of the product and the invention of a process for its production may not be absolutely coextensive, they have elements in common, the establishment of which renders both patentable.

II. The government brief makes an erroneous statement at p. 9 where it says:

> "Moreover, the legislative history of 35 U.S.C. 103 refutes the petitioner's assertion that the section was designed to change prior law and cause allowance of claims that had previously been disallowed."

Petitioner does not say the law has been changed, so claims to which he would not have been entitled under prior law should now be allowed. His assertion is just the opposite, i.e. that he is being refused claims which would have been allowed by the Patent Office as a matter of course under prior law. See the printed Transcript of Record at p. 24, where the Patent Office Board of Appeals said in its opinion:

> "We are well aware of the fact that in many cases of this type the process claims have been allowed almost as a matter of course along with the product claims . . . ."

Petitioner says 35 U.S.C. section 103 did not change the prior law as previously interpreted and understood by the Patent Office and the patent bar in this respect, and that it was error for the Court below to apply the statute as it did.

There now exists a serious controversy as to the correctness of the government's view that 35 U.S.C. Section 103 is a mere codification of existing law, as shown by the opinion of Judge Learned Hand in *Lyon* v. *Bausch & Lomb Optical Co.*, 224 F. 2d 530, 535 (C.A. 2) cert. denied, 350 U.S. 911. This is another reason why certiorari ought to be granted in this case.

III. The government brief at p. 7 quotes from *Rubber Company* v. *Goodyear*, 9 Wall. 788, 796 to the general effect that process claims and product claims are separate and independent with respect to patentability. While this proposition is generally true, this court recognizes an exception as is pointed out at p. 11 of our Petition, where, as here, a new process produces a new (chemical) substance.

Respectfully submitted,

DEAN LAURENCE
HERBERT I. SHERMAN
753 Warner Building
Washington 4, D. C.
Attorneys for Petitioner